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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,104	08/22/2001	Natalie Bryant	007051.P008	9322

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EXAMINER

SHAH, MILAP

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/935,104	Applicant(s) BRYANT, NATALIE	
	Examiner Milap Shah	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

This office action is in response to the amendment received on June 10, 2005 in which applicant amends claims 1, 6, & 8. No new claims were added and no claims were canceled. Thus, claims 1-8 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slot Machines A Pictorial Review - 1973 Bally "Circus".

Slot Machines A Pictorial Review - 1973 Bally "Circus" discloses a mechanical reel slot machine having a circus theme. Slot Machines A Pictorial Review - 1973 Bally "Circus" additionally discloses:

Regarding Claims 1, 6, and 8:

- the display means displays a plurality of spinning reels (See Figure),
- each reel carrying symbols from a set of symbols (See Figure),
- one of the symbols (monkey symbol) of the set of symbols on the reels of a gaming machine is a scatter symbol (See Figure and p. 119),

- in respect to at least one of the reels, the set comprising a plurality of the scatter symbols (monkey symbols), at least certain of the scatter symbols on said at least on reel being separated from each other on the reel by at most one symbol, so that when more than a minimum number of scatter symbols are displayed simultaneously at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols (See Figure and p. 119).

Although Slot Machines A Pictorial Review - 1973 Bally "Circus" discloses "an unusual play feature...the monkey special (scatter pay), which pays 20 coins for three monkeys in any position in the reel glass.", Slot Machines A Pictorial Review - 1973 Bally "Circus" possibly lacks explicitly disclosing:

Regarding Claims 1, 6, and 8:

- in respect to at least one of the reels, the set comprising a plurality of the scatter symbols (monkey symbols), at least certain of the scatter symbols on said at least on reel being separated from each other on the reel by no more than one symbol position, so that when more than one scatter symbols of the at least one reel is displayed simultaneously with scatter symbols occurring on any of the other reels at any one time when the reels are in a rest condition, all the displayed scatter symbols contribute to a single paying combination of the scatter symbols.

Regarding Claim 2:

- the display means is a video display unit and the display of the reels is constituted by a video simulation.

Regarding Claim 3:

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- the set of symbols on each of the reels has more than one occurrence of the scatter symbol.

Regarding Claim 4:

- the set of symbols of each reel has at least two scatter symbols.

Regarding Claim 5:

- the scatter symbols are positioned on each reel such that up to three scatter symbols are able to be displayed at any one time.

Regarding Claims 7 and 8:

- there are more special symbols able to be displayed than there are reels constituting the spinning reel game.

Regarding claim 2, to one having ordinary skill in the art at the time of Applicant's invention, having a display means to simulate spinning reels in a slot machine was notoriously well known. It would have been obvious to replace the display shown in Slot Machines A Pictorial Review - 1973 Bally "Circus" with a video display that simulates spinning reels. One would be motivated to do so in order to reduce the amount of time required to "spin" the reels. Reduced reel spin times equate to higher play rates and increased profits for casino operators.

Regarding claims 1, 3, 4, 5, 6, 7, and 8, it would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate more than one scatter symbol on at least one reel in a gaming machine, such as the gaming machine disclosed in Slot Machines A Pictorial Review - 1973 Bally "Circus". One would be motivated to do so because adding additional scatter symbols to a reel strip increases the probability that a player will obtain scatter symbols and hence an award for a scatter symbol combination making the gaming machine highly desirable to players.

Response to Arguments

Applicant's arguments and amendment with respect to the objection of claims 1-8 have been considered and are persuasive, thus, the claims objections of claims 1-8 have been withdrawn.

Applicant's arguments filed June 10, 2005 have been fully considered but they are not persuasive.

Applicant's argues that it would not have been obvious to one of ordinary skill in the art (game designer) to have modified Slot Machines A Pictorial Review - 1973 Bally "Circus" in such a way to add additional scatter (or special) symbols so that they are separated from each other on the reel by no more than one other symbol position. The Applicant uses "return to player percentage" as background evidence that such a particular set up of symbols would not have been obvious.

The examiner respectfully disagrees with Applicant's allegation. Clearly, one skilled in the art would find it to be a mere design choice to situate the current symbols and additional symbols within Slot Machines A Pictorial Review - 1973 Bally "Circus" in any possibly combination, such as the particular combination of Applicant's invention. Also, the calculations mentioned by the Applicant are notoriously well known in the art and a reason that Applicant's claimed particular arrangement of symbols on a reel strip may not been seen used in the gaming industry is for the fact that these calculations to persons of ordinary skill in the art disclose this particular arrangement may not have been profitable enough to the gaming establishments. It does not propose that the design choice or consideration is unobvious, since many upon many symbol arrangements are possible on the reel strips and it is considered a mere design consideration as to which arrangements (such as the particular combination discussed above) would have been used or tested by one of ordinary skill in the art at the time of the invention.

Applicant also argues that there is no motivation in the reference to modify the gaming machine in “this” manner. However, motivation may also come from one of ordinary skill in the art and the reasons given in the previous office action are maintained herein. One skilled in the art would be motivated to modify the reference because adding additional scatter symbols to a reel strip [in any proposed arrangement] increases the probability that a player will obtain scatter symbols and hence an award for a scatter symbol combination making the gaming machine highly desirable to players. The Examiner adds “in any arrangement” because the simple fact is, more scatter symbols in any conceivable arrangement on the reel strip, provides a higher chance that the display will stop with scatter symbols and hence, more awards, which creates a more desirable gaming machine for players.

The Examiner would like to show an example of a “reel strip” in which a particular symbol (1 BAR) which may be the “scatter” or “special” symbol is on each reel of a gaming machine and separated on the individual reels by no more than one other symbol. See figure 6A of U.S. 5,423,539 issued to Nagao on June 13, 1995. The reel strip of a gaming machine that is currently more than a decade old discloses like symbols both next to each other and not separated by more than 1 other symbol on a reel strip. The “1 BAR” symbol is easily replaceable with a scatter symbol, such as that disclosed by the Applicant to provide an award when at least two of the scatter symbols in the different reels are displayed. With regard to claim 8, in Nagao, the situation in which multiple reels display two scatter symbols on the display (which is quite possible), the condition is met that there are more of the “certain” symbols on the screen than there are columns.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into

account only knowledge which was within the level of ordinary skill (such elements as figure 6A of Nagao) at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 5,423,539 issued to Nagao. Nagao is used in the response to Applicant's remarks to further show a reel strip in which like symbols are both next to each other and separated by no more than one symbol.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.

A handwritten signature in black ink, appearing to read "Corbette E. Osburn". The signature is fluid and cursive, with the first name "Corbette" being more prominent.

CORBETTE E. OSBURN
PRIMARY EXAMINER